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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,960	11/27/2001	Koji Tokunaga	15124	1702
23389	7590	12/01/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			KAROVALIA, SAMIR	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,960

Applicant(s)

TOKUNAGA, KOJI

Examiner

Samir S. Karovalia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 3-6 of the remarks, filed 09/22/2005, with respect to figures 3, 4, and claims 1-3 have been fully considered and are persuasive. The Final Rejection of claims 1-3 and objections of figures 3 and 4 has been withdrawn. Claims 1-3 are now pending in the current application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. ("Qua"), US Patent No. 6,222,909 in view of Watkins, US Patent No. 6,859,609.

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The claims read on Qua as follows:

Qua teaches as pertains to claim 1, *A portable phone having a recording function for recording audio data during telephone conversation*, (see abstract; figure 1; col.1, ln.39-44; col.3, ln.22-27 which teaches a wireless phone)

said portable phone comprising: a plurality of memories, each [memory] for endless recording, as a conversation content, the audio data during the telephone conversation;

(in accordance with claim 2 limitations, the 2 memories are considered merely different memory areas of a single memory device. Qua teaches a single device by reference to the detachable storage unit 120 for example. Further, Qua teaches to be able to mark each of the portions of a conversation for later retrieval. The marking of a recorded audio data is considered to record the data in a different memory area in the single memory, as upon retrieval, that specific portion of memory would be accessed to retrieve the data in that location, col.3, ln.22-29 col.3, ln.44-47; col.5, ln.3-7; col.5, ln.25-31; col.5, ln.36-39)

a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio of a current conversation data instead of said first memory which endless-records, as the conversation content, the audio data until then;

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(Qua teaches the user enable to mark the audio data by initiating recording as noted above via col.5, ln.36-39, the marking is indicating the different memory area for use in later retrieval, and as the marking is enabled by a user input such is considered a switch as claimed herein as an activation sequence from the user is done via keypad, figure 2, 202-220)

and

a reproducing unit for reproducing the conversation content which said first memory endless-recorded before being switched by said switching unit, while the second memory endless-records the current conversation.

(Qua teaches the retrieval of audio notes via identification code, identifying the memory area of the stored note for retrieval col.6, ln.26-39 with use of similar types of control as for the recording as well as for replay (reproduction) col.6, ln.51-54 and thus each and every part of a sequence of notes including the one that was recorded in the first memory area can be reproduced. Qua fails to teach that a first memory reproduces a conversation content recorded, while the second memory records conversation contents of a current conversation.

However, Watkins discloses a portable digital terminal (PDT) which can record audio signals and/or digital video (A/V) during a conference meeting (conversations), See abstract and col. 1, lns.10&11. The PDT comprises plurality of memories (fig. 4, elements 140 and 148) which endless-record A/V

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from multiple sources, See col. 5, Ins.38-43, ln.62 - col. 6, ln.6 and col. 6, Ins.29-44. During the recording a segment of the recorded memory can be played back (reproduced) while the remainder of the session continues to record ongoing A/V data. The first memory 140 and the second memory 148 continuously (endlessly) store an audio track (i.e. conversation audio, See col. 5, Ins.48-52). Additionally, Watkins discloses that by providing simultaneous playback during recording would permit a person to review previous recordings without interrupting the ongoing recording and also permit editing, See col. 2, Ins.44-49 and Ins.58-63.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use Watkin's simultaneous playback and recording method with the teachings of Qua to provide Qua's audio note taking system with further capabilities to play a previously stored message content on a single or plurality of memories in which a conversation is reproduced from the first memory while another memory endless-records current conversation without interrupting the recording of the ongoing (current conversation) as disclosed by Watkins.

With respect to claim 2, Qua teaches *the memories are constituted by a plurality of memory areas of a single memory device*, (storage unit 120) as was noted above, *each of the memory areas being capable of individually endless-recording the audio data.*

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(in as far as 'endless-recording' is understood and defined by the disclosure, Qua teaches recording audio until the user or call is ended, each memory of the plural memory areas can contain the whole note or different memory areas can hold different portions of the audio note depending on the manner in which the user marks the audio note via the 'switching')

With respect to claim 3, Qua teaches *a key for operating said reproducing unit to reproduce the audio data;*

said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents.

(Qua teaches implantation of the various functions via keypad input col.6, ln.59- col.7, ln.12)

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir S. Karovalia whose telephone number is 571-272-8133. The examiner can normally be reached on Monday-Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante

S.S.K.
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